UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,488	11/05/2001	Siegfried K. Holz	P-1783	5623

7590 01/27/2006	**EXAMINER**
Charles J. Prescott	GLASS, RUSSELL S

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ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Office Action Summary	10/008,488	HOLZ, SIEGFRIED K.
	Examiner	**Art Unit**	
	Russell S. Glass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 November 2001</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-6</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-6</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/20/03*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1.   Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Joao,

(U.S. 6,283,761).

2.   As per claims 2 and 5, Joao discloses a method of preparing and fulfilling a

medication prescription written by a physician for a patient at the time of physical

examination comprising the steps of:

A.   providing a personal memory card (PMC) established for the benefit of, and

carried by the patient, said PMC configured to include a stored memory including the

patient's personal information, consulting physician information, accessible pharmacy

information, medical history, insurer information and an authentication code; (Joao, col.

2, line 63-col. 4, line 33; col. 7, lines 16-23; col. 8, line 31; col. 16, line 38 - col. 20, line

27; col. 26, line7-col. 27, line 8; col. 33, lines 26-37; col. 34, line 43-col. 35, line 10; col.

39, lines 37- col. 40, line 12)(describing all claimed information as being stored and

processed within main database, and being transferable for storage and/or processing

and updating to periphery P.D.A. devices and I.D. cards via internet. Security and

confidentiality is a pertinent function of the referenced system and the reference

discloses bar or bard codes for all pertinent functions, i.e. authentication code).

B.   reading said stored memory into a first PMC reader/writer from said PMC and

viewably presenting said stored memory on a personal digital assistant (PDA) in

conjunction with a physical examination of the patient by the physician, (Joao, col. 2,

line 63-col. 4, line 33; col. 7, lines 16-23; col. 8, line 31; col. 16, line 38 - col. 20, line 27;

col. 26, line7-col. 27, line 8; col. 31, line 10-col. 32, line 45; col. 33, lines 26-37; col. 34,

line 43-col. 35, line 10; col. 39, lines 37- col. 40, line 12);

C.   modifying said stored memory of said PMC by the physician via entry on said

PDA to include new medication prescriptions and additional medical history to form an

updated stored memory, (Joao, col. 2, line 63-col. 4, line 33; col. 7, lines 16-23; col. 8,

line 31; col. 16, line 38 - col. 20, line 27; col. 26, line7-col. 27, line 8; col. 31, line 10-col.

32, line 45; col. 33, lines 26-37; col. 34, line 43-col. 35, line 10; col. 39, lines 37- col. 40,

line 12);

D.   reading said updated stored memory of said PMC via a second PMC

reader/writer into to an office computer of the physician, said office computer configured

to electronically transfer said updated stored memory to a remotely located central host

server, (Joao, col. 2, line 63-col. 4, line 33; col. 7, lines 16-23; col. 8, line 31; col. 16, line

38 - col. 20, line 27; col. 26, line7-col. 27, line 8; col. 31, line 10-col. 32, line 45; col. 33,

lines 26-37; col. 34, line 43-col. 35, line 10; col. 39, lines 37- col. 40, line 12)(reference

discloses that all system components can have PMC reader/writers);

E.   transferring said updated stored memory to the host server by the Internet,

(Joao, col. 2, line 63-col. 4, line 33; col. 7, lines 16-23; col. 8, line 31; col. 16, line 38 -

col. 20, line 27; col. 26, line7-col. 27, line 8; col. 31, line 10-col. 32, line 45; col. 33, lines

26-37; col. 34, line 43-col. 35, line 10; col. 39, lines 37- col. 40, line 12);

F.   transmitting a prescription fulfillment request electronically by said host server for

new prescriptions contained within said updated stored memory to one of the accessible

pharmacies, said host server configured to store said updated stored memory and for

electronically transmitting said request, (Joao, col. 2, line 63-col. 4, line 33; col. 7, lines

16-23; col. 8, line 31; col. 16, line 38 - col. 20, line 27; col. 26, line7-col. 27, line 8; col.

31, line 10-col. 32, line 45; col. 33, lines 26-37; col. 34, line 43-col. 35, line 10; col. 39,

lines 37- col. 40, line 12);

G.   transmitting a confirmation electronically from one of the pharmacies selected in

step F back to said office computer advising that any new prescriptions are fulfilled,

(Joao, col. 2, line 63-col. 4, line 33; col. 7, lines 16-23; col. 8, line 31; col. 16, line 38 -

col. 20, line 27; col. 26, line7-col. 27, line 8; col. 31, line 10-col. 32, line 45; col. 33, lines

26-37; col. 34, line 43-col. 35, line 10; col. 39, lines 37- col. 40, line 12)(notification of

the occurrence of an event is considered to be transmitting a conformation).

H.   electronically transmitting appropriate insurer information by said host server

corresponding to the examination and new prescriptions, (Joao, col. 2, line 63-col. 4,

line 33; col. 7, lines 16-23; col. 8, line 31; col. 16, line 38 - col. 20, line 27; col. 26, line7-

col. 27, line 8; col. 31, line 10-col. 32, line 45; col. 33, lines 26-37; col. 34, line 43-col.

35, line 10; col. 39, lines 37- col. 40, line 12).

3.   As per claims 1,3, 4 and 6, these system claims contain essentially the same

limitations as corresponding method claims 2 and 5 and are therefore rejected on the

same basis as claims 2 and 5. The citations applied against method claims 2 and 5 are

hereby incorporated against claims 1,3, 4 and 6 by reference.

Furthermore, system claims 1, 3, 4 and 6 contain multiple statement of intended

use that fail to further limit the disclosed systems. For example, claim 1 discloses a

PMC including a modifiable stored memory including a patient's personal information,

consulting physician information, accessible pharmacy information, medical history,

insurer information and an authentication code. The listed information claimed as stored

on the modifiable stored memory disclose the intended use of the system and,

therefore, fail to further limit the claimed system. System claims 1, 3, 4 and 6 are

replete with similar intended use limitations that fail to limit the claimed subject matter.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure is as follows: Morey, (U.S. Pub. 2005/0182656); Edelson et al.,

(U.S. 5,737,539); Mayaud, (U.S. 5,845,255); and, Josh Fisher and Rosemary Wang,

The Cure Is In Hand, Bringing Information Technology To Patient Care, W.R.

Hambrecht & Co., October 2000, pp. 1-78.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RSG
12/16/05

C. LUKE GILLIGAN
PATENT EXAMINER